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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,599	12/23/2003	John Thomas Stites	005127.00245	1598
22908	7590	02/17/2005	EXAMINER	
BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606				BLAU, STEPHEN LUTHER
		ART UNIT		PAPER NUMBER
		3711		

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	el
	10/707,599	STITES ET AL.	
	Examiner Stephen L. Blau	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 December 2004.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-55 is/are pending in the application.  
 4a) Of the above claim(s) 6,7,11-19,21-32,38,39,43-51,54 and 55 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5,8,20,33-37,40,52 and 53 is/are rejected.  
 7) Claim(s) 9,10,41 and 42 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 1/8/04, 12/23/03. 7/29/04
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 6-7, 11-19, 21-32, 38-39, 43-51, and 54-55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 20 December 2004.

***Information Disclosure Statement***

2. The information disclosure statement filed 8 January 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. This application does not contain any of the foreign or Non-patent literature documents. In addition, the information disclosure statement filed 8 January 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. As well as a copy there is no English explanation of the foreign

references. It has been placed in the application file, but the information referred to therein has not been considered.

***Double Patenting***

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Applicant is advised that should claim 52 be found allowable, claim 53 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

***Claim Objections***

5. Claim 52 is objected to because of the following informalities: The faxed copy of the amendment dated 20 December 2004 is very hard to read due to the faxing process. A new set of claims is required. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 8, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunikoski.

Dunikoski discloses a rear cavity (106) opposite a striking face (Fig. 2), a bridge member in the form of back plate (22) extending across the rear cavity (Fig. 2), the bridge member having a front surface and a back surface (Fig. 2), a weight (68, 70) attached to the bridge member (Fig. 2) which will vary a position of a center of gravity of a head compared to if the weight member was not there, a weight member being movable to a different locations (38, 48) on a bridge member, different locations on a bridge member are fixed (Fig. 2), and a weight being interchangeable with a plurality of

alternate weights in the form of weights 68 and 70 are able to be interchangeable with one another (Fig. 2).

8. Claims 1-5, 8, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lu.

Lu discloses a rear cavity (34) opposite a striking face (Fig. 2), a bridge member extending across the rear cavity (38), the bridge member having a front surface and a back surface (Figs. 3a-3c), a weight attached to the bridge member which will vary a position of a center of gravity of a head compared to if the weight member was not there (48), a weight member being movable to a different locations on a bridge member in the form of different holes (44), different locations on a bridge member are fixed (Fig. 2), and a weight being interchangeable with a plurality of alternate weights in the form of weights 48 and 48 are able to be interchangeable with one another (Fig. 2), and weight attached to the a bridge member with a set screw (Fig. 5) with weight being a weight chip in the form of a head of a screw (Fig. 5).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 33-37, 40 and 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu in view of Gilbert.

Lu lacks a set of irons increasing in number comprising 2-9 irons and a pitching wedge. Gibert discloses a set of irons comprising 2-9 irons and a pitching wedge (Fig. 5). In view of the patent of Gibert it would have been obvious to modify the iron of Lu to have a set of irons increasing in number comprising 2-9 irons and a pitching wedge in order to have the advantages of Lu for a set of irons.

### ***Allowable Subject Matter***

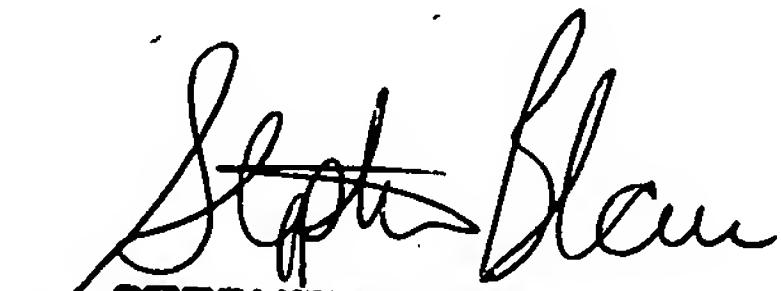
11. Claims 9-10 and 41-42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art discloses or renders as obvious a bridge member extending across a rear cavity, a weight attached to the bridge member, a weight movable to different locations, and an alternate weight having a different mass or different shape than the weight in addition to the other elements of structure claimed.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 16 February 2005



STEPHEN BLAU  
PRIMARY EXAMINER